

No. 13389

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT.

ROLLEY, INC.,

Defendant-Appellant,

vs.

JAMES L. YOUNGHUSBAND and HOWARD YOUNG-
HUSBAND, Co-partners, Doing Business As CONSOLI-
DATED COSMETICS and LES PARFUMS DE DANA,
INC.,

Plaintiffs-Appellees.

BRIEF ON BEHALF OF PLAINTIFFS-APPELLEES.

WILLIAM C. MACKAY,
111 Sutter Street,
San Francisco, California,

JAMES R. MCKNIGHT,
ROBERT C. COMSTOCK,
. 1 North La Salle Street,
Chicago, Illinois,
Attorneys for Plaintiffs-Appellees.

SUBJECT INDEX

	PAGE
Jurisdiction	1
Statement of the Case	3
Argument	5
Title to the trade marks set forth in the complaint is established as in plaintiffs by the record and exhibits	5
Plaintiffs are entitled to the benefits of the Act of 1946	6
Plaintiffs' products bearing its trade marks have been for many years and are now sold in all principal stores from coast to coast	7
Plaintiffs' registration and ownership of the trade marks Tabu, Taboo and Forbidden are not contested by defendant	9
Forbidden Flame is an infringement of Forbidden, Tabu, and Taboo	10
Plaintiffs' registration of Voodoo is prior to the earliest claim of use of Voodoo which defendant makes in its pleadings	12
Plaintiffs' registrations are prima facie evidence of plaintiffs' ownership of the trade marks covered by the registrations	13
Plaintiffs' registrations not only imply ownership but also use	15
Plaintiffs are entitled under their registrations to the filing dates of the applications which resulted in the registrations, as their first dates of use	17
Defendant has the burden of proving by the preponderance of the evidence that its use of Voodoo was prior to the date of plaintiffs' application for registration of Voodoo	18

Defendant's background is pertinent as to credibility of its proofs	20
Defendant made no trade mark search prior to using Voodoo	22
An analysis of defendant's evidence discloses that defendant has not sustained its burden of proof of any date of use of Voodoo earlier than plaintiff's registration	23
Defendant's claim that plaintiffs are not entitled to rely on their registrations is without merit	31
Defendant mistakenly claims that plaintiffs' Voodoo registration has expired. It has not expired and is in full force and effect	33
The California and federal cases cited by defendant require that plaintiffs' registrations be sustained	34
Pertinent cases of this court, the Supreme Court of the United States and other Courts of Appeal sustain plaintiffs' position	37
The purchasing public associates Tabu, Forbidden and Voodoo with plaintiffs	38
Plaintiffs not only have registrations with prior dates but their products have been sold and are now being sold in California and throughout the United States	40
Plaintiffs' trade marks have been adjudicated by the courts and recognized by the Trade	42
Defendant's counterclaim on Voodoo is without basis and should be dismissed	42
The preliminary injunction issued by Judge Erskine restraining defendants from suing any of plaintiffs' customers for alleged infringement of Voodoo and made a permanent injunction by Judge Roche after trial, should be affirmed	44
Defendant had a fair trial. There was no prejudice in the decision of the District Court	46
Conclusion	48

CASES CITED.

American Trading Co. v. H. E. Hancock, 295 U. S. 247 ..	35
Brewster v. Dairy Maid, 62 F. 2nd 844	18
California Fruit Growers v. Windsor Beverages, 118 F. 2nd 149	38
Cole of California v. Grayson, 72 C. A. 2nd 772	35
D. J. Bielzoff v. White Horse, 107 F. 2nd 585	16
Del Monte v. California Packing Corp., 34 F. 2nd 774 ..	37
Derringer v. Plate, 29 Cal. 292	34
Doll Craft Co. v. Nancy Ann, 94 F. Sup. 1	13
Elgin National Watch Co. v. Elgin Razor Corp., 25 F. Sup. 886	21
Ely & Walker v. Sears, Roebuck & Co., 90 F. 2nd 257	15
Etalissements Rene Beziers v. Reid Murdock & Co., 9 U.S.P.Q. 23	18
Federal Products Co. v. Lewis, 23 F. 2nd 757	17
Helena Rubinstein Inc. v. Agazin, 81 U.S.P.Q. 59	14
Lehn & Fink v. Wyeth, 77 U.S.P.Q. 633	16, 32
Lentheric v. Willingmyre, 45 U.S.P.Q. 687	37
Maytag Co. v. Meadows Mfg. Co., 35 F. 2nd 403	45, 46
McLellan Stores Co. v. Concord & Co., Inc., 18 F. 2nd 826	36
Mishawaka Co. v. Kresge Co., 316 U. S. 203	38
Pecheur Co. v. National Co., 315 U. S. 666	35
Penn Co. v. M. L. B. & T. Co., 72 F. 2nd 422	21
Rainier Brewing Co. v. McCalagon, 94 C.A. 2nd 118	35
R. R. Baker v. Lebow Bros., 66 U.S.P.Q. 233	19
Rosengart v. Ostrex, 136 F. 2nd 249	14

	PAGE
Safeway Stores Inc. v. Dunnell, 80 U.S.P.Q. 115	37
Stork Restaurant v. Sabatine, 76 U.S.P.Q. 374	2, 37
Trade Mark Act of 1946	
Sections 32, 34, 35 and 39	3
Section 7(b)	6
Section 22	23
Section 33	13
Trade Mark Cases, 100 U. S. 82	35
United Drug v. Rectanus, 248 U. S. 90	35
U. S. C. A., Vol. 15, Page 280	6
Weatherford v. Eytchison, 9 C.A. 2nd 379	34
Weiner v. National Co., 123 F. 2nd 96	14
Wells, Lamont Co. v. Blue Ridge Overalls Co., 77 U.S.P.Q. 542	17
Western Stove Co. v. Geo. D. Roder, 82 F. 2nd 206	
.....	13, 18, 32
Willson v. Graphol, 89 U.S.P.Q. 382	23

No. 13389

IN THE
United States Court of Appeals

FOR THE NINTH CIRCUIT.

ROLLEY, INC.,

Defendant-Appellant,

vs.

JAMES L. YOUNGHUSBAND and HOWARD YOUNG-
HUSBAND, Co-partners, Doing Business As CONSOLI-
DATED COSMETICS and LES PARFUMS DE DANA,
INC.,

Plaintiffs-Appellees.

BRIEF ON BEHALF OF PLAINTIFFS-APPELLEES.

JURISDICTION.

The complaint herein sets forth that "This is an action under the trade mark laws of the United States" (R. 3).^{*} Defendant-appellant^{*} admits this fact in its answer (R. 11)^{*}

Plaintiffs-appellees'^{*} trade mark VOODOO was granted registration No. 363,746 on January 3, 1939, for perfume and cosmetics by the United States Patent Office (R. 4,

^{*} R. indicates the printed record, and the number following the page thereof. PX indicates Plaintiffs-Appellees' Exhibit and the number following, that of the exhibit.

In this brief Plaintiffs-Appellees and Defendant-Appellant will be referred to as Plaintiffs and Defendant respectively.

80). This registration, issued under the Act of 1905, was affirmed under the Act of 1946, so that plaintiffs are entitled to the remedies and benefits of the Act of 1946 (R. 80).

Sections 32, 34, 35 and 39 of the Trade Mark Act of 1946 are pertinent, establishing that the District Court had original jurisdiction and this Court has appellant jurisdiction in this case.

The complaint also alleges that this action is “between citizens of different states, in which the amount in controversy exceeds, exclusive of interest and costs, the sum of \$3,000.00” (R. 3, 4). Plaintiffs are of Chicago, Illinois, and New York, New York, and defendant is a California corporation (R. 3). This is admitted in defendant’s answer (R. 11). Jurisdiction is also established therefor as set forth in the following case:

In *Stork Restaurant, Inc., v. Sabatine*, 76 USPQ 374, this Court restrained defendant from using Stork Club on a restaurant in San Francisco in view of plaintiffs’ prior use of STORK CLUB in New York. The Court said:

“Ownership of a trade name is a property right. It is made so by statute in California. Sections 14,400; 14,401 and 14,402 of The Business and Professions Code (Deering 1944).”

STATEMENT OF THE CASE.

This is a suit for trade mark infringement and unfair competition (R. 3-9). Plaintiffs are famous in the perfume industry and their TABU, TABOO, FORBIDDEN and VOODOO perfumes and toilet waters are sold in every important department and drug store in San Francisco, Los Angeles and other California cities and in every state of the Union (R. 89, 90). Because of the extensive advertising of plaintiffs' products and the excellence of their quality, the sales of plaintiffs' products have exceeded 32 million dollars (R. 90). The purchasing public has come to recognize products bearing the trade marks TABU, TABOO, FORBIDDEN and VOODOO only as plaintiffs' products, and has made these trade marks valuable property rights (R. 90).

Plaintiffs' said trade marks are registered in the United States Patent Office and in the Office of the Secretary of State of the State of California (R. 75-88, 102).

Defendant Rolley, Inc., is dominated by its president, founder and predecessor, Charles A. Rolley (R. 112, 156). Mr. Rolley was originally in the shoe dye business (R. 157). In his spare time he began copying wellknown perfumes (R. 125, 164, 188, 189, 194-197), and did so well at it that he dropped the shoe dye business and formed the defendant corporation (R. 187). TABU was among the perfumes which Mr. Rolley copied (R. 193). He also used the trade mark FORBIDDEN FLAME (R. 117), which plaintiffs urge is an infringement of plaintiffs' FORBIDDEN, TABU and TABOO. Later Mr. Rolley came out with his infringing VOODOO perfume and toilet water (R. 132).

The District Court found that defendant “has, at dates later than the first use of the trade mark VOODOO by plaintiffs and without plaintiffs’ consent, used the trade mark VOODOO on and in connection with the sale of perfume and toilet water” (R. 43), and enjoined defendant from further use of said trade mark (R. 45). Since defendant had abandoned the trade mark FORBIDDEN FLAME, the District Court held that no further order was considered necessary with respect to the trade marks TABU, TABOO and FORBIDDEN (R. 44).

Defendant filed a cross complaint for infringement on the trade mark VOODOO (R. 16-21), but in view of plaintiffs’ prior use and registration of VOODOO, the counterclaim was dismissed (R. 46).

In its cross complaint defendant had filed suit against not only plaintiff but also 21 prominent stores who were plaintiffs’ customers for alleged infringement of the trade mark VOODOO (R. 16-21). Plaintiffs’ motion for temporary injunction to restrain defendant from proceeding with this suit against 21 stores and from filing further suits against any of plaintiffs’ customers was granted by Judge Erskine after full briefs and hearings (R. 21-33). This injunction was made permanent by Judge Roche after the trial herein (R. 46).

The three principal questions before this Court are whether this Court should not affirm the District Court in

1. Restraining defendant from infringing plaintiffs’ registered trade marks VOODOO, TABU and FORBIDDEN,
2. Dismissing defendant’s counterclaim alleging infringement of the trade mark VOODOO, and
3. Restraining defendant from suing plaintiffs’ customers for alleged infringement of the trade mark VOODOO.

ARGUMENT.

Title to the Trade Marks Set Forth in the Complaint Is Established as in the Plaintiffs by the Record and Exhibits.

The trade mark registration of VOODOO No. 363,746 is in evidence as plaintiffs' Exhibit 8 (R. 80). It was issued by the United States Patent Office to Associated Distributors, Inc., one of plaintiffs' predecessors, on January 3, 1939 (R. 80).

Certified copies are offered in evidence for the registrations TABU No. 314,493 (PX 2); TABU No. 407,797 (PX 3); TABU No. 426,323 (PX 4); TABOO No. 343,897 (PX 5); TABOO No. 437,162 (PX 6); FORBIDDEN No. 408,529 (PX 7); and VOODOO No. 363,746 (PX 8). Copies of these registrations were identified by the witness Gaumer as obtained from the official files of the United States Patent Office (R. 88).

Plaintiffs' titles to the various registrations are in good order and established by Mr. Gaumer's painstaking testimony (R. 72-88), and by certified copies of registrations and assignments all showing the passing of the good will connected with the business with which said trade marks were used. (Plaintiffs' Exhibits 1-17.)

Defendant's counsel at the outset of the trial conceded plaintiffs' title when he said "with relation to VOODOO and registration for VOODOO, we do not challenge they have the certificate here and do not raise any objection to the foundation" (R. 80).

Plaintiffs also own registrations of TABU, FORBIDDEN and VOODOO issued by the Secretary of State of

California. The originals of the registrations are offered in evidence as plaintiffs' Exhibits 98, 99 and 100 (R. 102, 107).

The District Court found that title to the trade marks and registrations was in plaintiffs (R. 43-44).

**Plaintiffs Are Entitled to the Benefits
of the Act of 1946.**

All of plaintiffs' registrations have been duly republished under the Act of 1946 (R. 74-81, PX 2-8). Under Sec. 12(c) of said Act of 1946, plaintiffs became entitled to "the benefits of this Act for said marks".

Defendant asks, "What benefits are plaintiffs entitled to under the Act of 1946?" This is answered on page 280 of 15 USCA as follows:

"Whereas a 1905 registration was prima facie evidence of ownership, a principal registration (under the Act of 1946) is prima facie evidence of ownership, validity of the registration, and of the registrant's exclusive right to use the mark in commerce."

"The greatest single advantage of a principal registration is that it is constructive notice of the registrant's claim of ownership. This means simply that as long as the mark remains on the principal register, anyone is charged with notice of claim of ownership, and no rights may be claimed in the mark of another who commenced to use it after the registration issued * * * such use cannot be justified by a claim of innocence, good faith or lack of knowledge. Its practical effect is to give nationwide effect to a principal registration."

Section 7(b) of the Act of 1946 provides:

"A certificate of registration of a mark upon the principal register provided by this Act shall be prima facie evidence of the validity of the registration,

registrant's ownership of the mark, and of registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate."

Defendant is violating plaintiffs' exclusive right to use its registered marks under the Act of 1946, and plaintiffs are entitled to relief against such infringement.

Plaintiffs' Products Bearing Its Trade Marks Have Been For Many Years And Are Now Advertised And Sold In All Principal Stores From Coast To Coast.

In San Francisco plaintiffs' perfumes and cosmetics are sold in the City of Paris, The Emporium, I. Magnin, Roos Bros., Raphael-Weill, Macy's, Hale Bros., H. Liebes & Company, J. Magnin, The White House and Owl Drug Company, and many other stores (R. 89).

In Oakland plaintiffs' TABU and VOODOO lines are sold in H. C. Capwell, Sullivan & Furth, I. Magnin, J. Magnin, Kuhn's, and many other stores (R. 89-90). In Los Angeles the following stores carry plaintiffs' products: Robinson's, Bullock's, Magnin's, The Broadway, The May Company, Owl Drug, Whelan Stores, Eastern Columbia, Haggerty's, and Saks Fifth Avenue (R. 90). Plaintiffs' perfumes, colognes and other cosmetics bearing their famous trade marks are sold in all of the principal stores in California, Oregon, Washington and "from coast to coast in every city in the United States" (R. 90).

The sales of plaintiffs' TABU, TABOO, FORBIDDEN and VOODOO perfumes and colognes have been extensive. They have exceeded thirty-two million dollars throughout the United States (R. 90). VOODOO sales have already passed a quarter of a million dollars (R. 90).

Plaintiffs' famous TABU, TABOO, FORBIDDEN and

VOODOO products are offered in evidence as plaintiffs' Exhibits 18 to 23 (R. 91, 108).

Plaintiffs' national distribution of its trade marked products is backed by millions of dollars in national advertising in high grade magazines of national distribution such as Harper's Bazaar, Town and Country, Vogue, and locally in all the important daily newspapers (R. 91). Typical TABU advertisements are offered in evidence as plaintiffs' Exhibits 24 to 41 inclusive to show plaintiffs' tremendous advertising (R. 92). These advertisements begin with September of 1941 to date (R. 93). Plaintiffs' trade mark FORBIDDEN is also featured in all of these advertisements (R. 93). Typical VOODOO advertisements are offered in evidence as plaintiffs' Exhibits 42 to 84 inclusive (R. 94). Of these VOODOO advertisements, PX 42-44 appeared in such nationally distributed magazines as Harper's Bazaar, Vogue, Beauty Fashion and The New Yorker (R. 94).

Mr. Gaumer testified "There have been hundreds of advertisements of plaintiffs' perfumes and colognes in metropolitan newspapers in San Francisco, Oakland, Los Angeles, and other cities. For instance, plaintiffs' Exhibit 49 is for VOODOO perfume by the City of Paris, appearing in the San Francisco Examiner for December 21, 1950; plaintiffs' Exhibit 50 is a VOODOO advertisement appearing in Haggerty's store advertisement in the Los Angeles Times for December 11, 1950. Plaintiffs' Exhibits 51 and 52 are large advertisements of plaintiffs' VOODOO perfume by Robinson's, one of the largest stores in Los Angeles. These ads appeared in the Los Angeles Times. Plaintiffs' Exhibit 54 is an advertisement of VOODOO and TABU perfume, appearing in Seattle, Washington. Plaintiffs' Exhibits 56 and 57 are VOODOO ads in the Portland, Oregon, newspaper.

Other advertisements are shown in this group of exhibits throughout the United States including the West Coast" (R. 96-97).

Such advertising of plaintiffs' products has exceeded \$2,380,000 (R. 96). The plaintiffs are all related companies and cooperate together in the production and sale of the trade marked products involved in this case (R. 97).

The advertising and sale of plaintiffs' TABU, TABOO, FORBIDDEN and VOODOO perfumes and colognes and cosmetics has been so extensive that there are very few women in the metropolitan districts of the United States who have not heard of plaintiffs' said products (R. 102). These trade marks have become so well and favorably known that they are associated with plaintiffs and their products, and said trade marks are understood to mean to the trade and the purchasing public that products sold under or by said trade marks are the products of plaintiffs (R. 102, 103).

Because of the extensive sale, the widespread advertising and the high quality of plaintiffs' trade marked products, plaintiffs own a valuable asset in the good will associated therewith.

Plaintiffs' Registration and Ownership of the Trade Marks Tabu, Taboo and Forbidden Are Not Contested by Defendant.

In paragraph 6 of the complaint, plaintiffs plead:

"Plaintiff is now and has been for some time last past the owner of said trade marks TABU, TABOO, FORBIDDEN and VOODOO and registrations Nos. 314,493; 407,797; 426,323; 343,897; 437,162; 408,529 and 363,746 therefor, issued by the United States

Patent Office, and registrations Nos. 27,543; 30,388 and 32,733 issued by the Secretary of State of California, together with the good will of the business and that of its predecessors, and said registrations are valid, subsisting, uncanceled and unrevoked.” (R. 4.)

In its answer, defendant makes no response to paragraph 6 as to TABU, TABOO and FORBIDDEN (R. 11-16). Since there are no denials, the facts pleaded in paragraph 6 of the complaint as to TABU, TABOO, and FORBIDDEN are admitted by the defendant.

Forbidden Flame Is An Infringement Of Forbidden, Tabu and Taboo.

Charles A. Rolley, president of the defendant, testified on discovery deposition that there had been sales of FORBIDDEN FLAME perfume and cologne (R. 115, 116). Rolley included FORBIDDEN FLAME perfume in a list which he admits (R. 196). Rolley also admits selling FORBIDDEN FLAME perfume (R. 197). This list (PX 1) is brazenly headed ROLLEY REPRODUCTIONS. Naturally, with TABU perfume known throughout the nation as THE FORBIDDEN PERFUME, Rolley's FORBIDDEN FLAME was obviously intended as a copy or reproduction of plaintiffs' TABU (R. 101). Rolley's glib but lame excuse that FORBIDDEN FLAME was a copy of TOUJOURS MOI (R. 197), is rebutted by Rolley's admission that he knew of TABU before coming out with FORBIDDEN FLAME (R. 116-117), had seen advertising of TABU as THE FORBIDDEN PERFUME (R. 118), and that both TABU and FORBIDDEN FLAME had a distinct oriental fragrance (R. 121). On cross examination Mr. Rolley was asked, "Did you ever copy TABU?" and he answered, "I have copied TABU" (R. 193). It is apparent that Rolley's use of

FORBIDDEN FLAME was a deliberate attempt to reproduce plaintiffs' trade mark as well as plaintiffs' fragrance and to benefit thereby.

Plaintiffs' Exhibit 21 for plaintiffs' FORBIDDEN perfume disposes of defendant's claim of non use, as does plaintiffs' registration of FORBIDDEN in the United States Patent Office, in evidence as plaintiffs' Exhibit 7 (R. 79). Plaintiffs' Exhibits 24 to 41 all show use of FORBIDDEN in connection with TABU, which is known as THE FORBIDDEN PERFUME (R. 93). TABU and FORBIDDEN are synonymous (R. 93). They both mean the same thing. Naturally, the Patent Office will grant registrations for synonymous trade marks to the same owner or a related company. For instance, the Coca Cola Company owns trade mark registrations for both COCA COLA and COKE. They are synonymous. What could possibly be fraudulent about that?

FORBIDDEN FLAME is submitted as an infringement of FORBIDDEN and also of TABU.

Plaintiffs' Exhibit 1 shows defendant's use of FORBIDDEN FLAME. Mrs. Anis, one of defendant's witnesses, knew about FORBIDDEN FLAME perfume, that its number was 15 and "If there was a call for it, we had it in bulk" (R. 263).

Defendant's use of FORBIDDEN FLAME was certainly subsequent to plaintiffs' registration of TABU 314,493, issued July 3, 1934. Rolley claims 1939 for FORBIDDEN FLAME (R. 115).

Any further or future use of FORBIDDEN FLAME by defendant should be restrained. If defendant has discontinued use of FORBIDDEN FLAME, such restraint will cause it no distress of any kind.

Mr. Rolley, who dominates the corporation defendant, Rolley, Inc., admitted that he copied plaintiffs' TABU perfume. He testified outright in his own words—"I have copied TABU" (R. 174). It is inescapable that FORBIDDEN FLAME must have been used on the fake TABU that Mr. Rolley created.

The District Court found that defendant had abandoned FORBIDDEN FLAME and discontinued its use and that there was no need for any further order (R. 44). Plaintiffs submit that any further copying of TABU and use of FORBIDDEN FLAME should be enjoined.

Plaintiffs' Registration of Voodoo Is Prior to the Earliest Claim of Use of Voodoo Which Defendant Makes in Its Pleadings.

Plaintiffs' registration of the trade mark VOODOO for cosmetics No. 363,746 was issued by the United States Post Office on January 3, 1939, on an application filed on September 10, 1938 (PX 8, R. 80).

Defendant pleads in paragraph 1 of its cross complaint: "Commencing on or about the 15th day of April 1940, (defendant) created, used and employed the name VOODOO" (R. 16). The District Court did not permit defendant to amend this date (R. 71-72).

Defendant pleads in paragraph 3 of its counterclaim: "That beginning on or about the 15th day of April 1940, the defendant as cross-complainant and its predecessor have been the owners of the trade mark VOODOO" (R. '17).

In paragraph 6 of its counterclaims defendant pleads: "That ever since the 15th day of April 1940, hereinbefore stated, defendant and cross-complainant and its predecessor have been and still are the sole proprietors and

owners of the trade name VOODOO and all right, title and interest in and to the same'' (R. 19).

Since April 15, 1940, is subsequent to plaintiffs' registration date of January 3, 1939, and plaintiffs' application date of September 10, 1938, there can be no doubt that plaintiffs have prior rights to the trade mark VOODOO and that defendant's use constitutes an infringement.

A study of defendant's proofs, hereinafter set forth, will disclose that defendant made no actual use of VOODOO on perfume earlier than 1943.

Plaintiffs' Registrations Are Prima Facie Evidence of Plaintiffs' Ownership of the Trade Marks Covered by the Registrations.

A registered trade mark has always been regarded prima facie as a valid mark before the Courts.

Section 33 of the Act of 1946 codifies the Common Law on this point as follows:

“Sec. 33. (a) Any certificate of registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this Act and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of registrant's exclusive right to use the registered mark in commerce on the goods or services specified in the certificate * * *”

This Court stated in *Dollcraft Co. v. Nancy Ann*, 94 Fed. Sup. 1:

“The registration of a name raises a presumption of its legality.”

The D.C.S.D. California in *Western Stove Co. v. Geo. D. Roper*, 82 Fed. Sup. 206, stated that the:

“registration No. 437,191 is prima facie evidence of ownership (U.S. Code Title 115, Sec. 96).”

In *Weiner v. National Co.*, 123 Fed. 2nd, 96, the CCA7, speaking of a trade mark registration said:

“A strong presumption exists as to the validity of the mark.”

In *Helena Rubenstein, Inc., v. Agazim*, 81 USPQ 59, the respondent claimed that there should be a dismissal because no testimony had been taken as to use. The Commissioner, in denying this contention, said:

“Opposer made its prior registration of record and the ownership thereof constitutes prima facie proof of ownership and use of the mark.”

Plaintiffs' registrations of TABU, TABOO, FORBIDDEN and VOODOO are therefore prima facie valid before this Court.

Plaintiffs also offered in evidence certified copies of assignments of these registrations from the predecessors of plaintiffs, the original registrants down to the plaintiffs (R. 82-88).

In *Rosengart v. Ostrex Co.*, 136 Fed. 2nd 249, before the U.S.C.C.P.A. the petitioner relied upon his trade mark registration and copies of assignments. The Court said that such proof was sufficient without the need of further testimony of use of the mark:

“One who owns a mark is presumed to be using it because a mark ceases to be owned when it is not used in connection with a business, and if the registration is prima facie evidence of ownership and use, it would seem to follow that an assignment of the same, made and recorded in accordance with the statute, gives further evidence of use or negatives abandonment of the mark. We think the Commissioner properly held: ‘There being no evidence to the contrary, its registration proves ownership, and ownership implies use.’”

As to the original registrations, defendant made no objection as to TABU, TABOO or FORBIDDEN and as to VOODOO defendant's counsel stated, "We have no objection to it being received as to ownership of the certificate outlined therein" (R. 109).

As to the assignments, defendant's counsel stated, "We do not challenge they have the certificate here and do not raise any objection to the foundation" (R. 80).

**Plaintiffs' Registrations Not Only Imply
Ownership But Also Use.**

A registration of a trade mark duly issued by the United States Patent Office implies that such mark has also been used and is being used.

The law is very clearly defined by the following cases on the subject.

In *Ely & Walker v. Sears, Roebuck & Co.*, 90 Fed. 2nd 257, the U.S.C.C.P.A. said:

"Registration of a trade mark is prima facie evidence of its ownership * * * Upon the question of use by opposer of its mark on a trade mark, which counsel for appellant insists is placed in issue by denial of such use in the answer, it need only be said first that ownership implies use."

In the above cited case plaintiff took no testimony and relied upon a copy of its trade mark registration which it offered in evidence. Defendant claimed that because plaintiff took no testimony that no use had been established by the plaintiff. The Court held that the registration was sufficient and said:

"The foregoing indicates that counsel for appellant (defendant) overlooked the effect of the statutory provision making a registration prima facie evidence of ownership."

This case is pertinent to the case at bar. Defendant did not attack plaintiffs' registrations. Defendant did not even attend plaintiffs' deposition in Chicago, nor cross examine plaintiffs' witness. Defendant has not shown that plaintiff did not use the trade marks VOO-DOO, TABU and FORBIDDEN. Defendant seems to assume that plaintiff must put in evidence testimony of witnesses as to use by plaintiff of its trade mark. This is entirely unnecessary because with plaintiffs' registrations in evidence, such registrations imply ownership, and ownership implies use. These presumptions have not been overcome or even attacked. Under the authorities plaintiffs are entitled to the statutory protection of their registrations—which imply ownership and use.

In *D. J. Bielzoff v. White Horse*, 107 Fed. 2nd 585, the U.S.C.C.P.A. held that petitioner need offer no further proof than its trade mark registration and said:

“There is no evidence of record relative to the use of appellee's (Petitioner's) trade mark BLACK HORSE in the United States, and although counsel for appellant argue that it is not used in this country, it is sufficient to say that appellee's registration is prima facie evidence of ownership and will be considered as prima facie valid in this proceeding.”

The foregoing case is pertinent, because appellant's counsel therein thought plaintiff should offer witnesses to show sales in the United States. The registration was sufficient. Such use was presumed. In the case at bar defendant's counsel seems to feel that plaintiff should take testimony to show sales in California. Such use in California is presumed by plaintiffs' Federal registrations.

In *Lehn & Fink v. Wyeth*, 77 USPQ 633, the Commissioner held:

“In the absence of contrary evidence, registration is prima facie evidence of registrant’s ownership and use of mark.”

Defendant offered no evidence to the contrary in the case at bar, so plaintiffs’ registrations are prima facie evidence of ownership and use.

Plaintiffs Are Entitled Under Their Registrations to the Filing Dates of the Applications Which Resulted in the Registrations As Their First Dates of Use.

Under the registrations, which provides plaintiffs with evidence of ownership and use, plaintiffs’ date of use goes back as early as its filing date of the applications which resulted in the registrations.

In *Wells, Lamont Corp. v. Blue Ridge Overalls Co.*, 77 USPQ 542, the Commissioner of Patents said:

“When a registration issues, the date on which its application was regularly filed is that which must be accepted as prima facie evidence of ownership.

“Registration is prima facie evidence of ownership and use not only as to the date of registration but of the date on which application was filed.”

In *Federal Products Co. v. Lewis*, 23 Fed. 2nd 759, the Court of Appeals for the District of Columbia stated:

“Inasmuch as the applicant took no testimony, its filing date is the earliest date that it can claim.”

As to VOODOO, plaintiffs are entitled to September 10, 1938, as the date of use of VOODOO, as this date is the date on which the application was filed in the United States Patent Office which later resulted in plaintiffs’ registration No. 363,746 of VOODOO in evidence in this case (PX 8, R. 80). This is earlier than the date of April 15, 1940, pleaded in defendant’s cross complaint (R. 16-20).

Defendant Has the Burden of Proving by the Preponderance of the Evidence That Its Use of Voodoo Was Prior to the Date of Plaintiffs' Application for Registration of Voodoo.

Defendant has the burden of proving by the preponderance of the evidence any date of use of VOODOO prior to the application date which appears on plaintiffs' registration of VOODOO.

Such proof should be more than mere oral allegations by defendant's president, Mr. Rolley, or any others who claimed to have bought or sold defendant's VOODOO products. Documentary proof with dates appearing thereon are ordinarily required by the Courts and the Patent Office to prevent guessing or fraud. All doubts are to be resolved against the newcomer in any claims of priority. The authorities are as follows:

In *Western Stove Co. v. Geo. D. Roper*, 82 Fed. Sup. 206, the D. C. S. D. California ruled for the intervener who had a registered trade mark. The Court said:

“Intervener's registration No. 437,191 is *prima facie* evidence of ownership (U.S.C. Title 15, Sec. 96) and where one claims ownership of a mark as against one who has registered the mark, the burden of proof is upon such claimant.”

In *Etalissements Rene Beziere v. Reid Murdock & Co.*, 9 USPQ 231, the U.S.C.C.P.A. held that a junior party attacking a registration has the burden to establish “by a preponderance of evidence” his claim of prior use and ownership.

In *Brewster v. Dairy Maid*, 62 Fed. 2nd 844, the CCPA held:

“The burden of proof is upon the junior party in a trade mark interference and all doubts must be resolved against him.”

In *R. R. Baker v. Lebow Bros.*, 66 USPQ 233, the CCPA said and held:

“It has become well settled law that one who seeks to prove priority of ownership and use of a trade mark over the application date of a registered mark must do so by a preponderance of the evidence * * * of course, against a registered mark all doubts must be resolved against the junior party * * * he is under a heavy burden and his proof must be clear and convincing.”

Defendant has admitted that it has no documentary or written proof of early sales of VOODOO products. In Mr. Rolley’s discovery deposition it appears as follows on (R. 67-68):

Q. So that all the information you have is oral, only from your memory in regard to those early sales of VOODOO?

A. That’s right.

Q, You don’t have any written documents on the subject at all?

A. No.

Q. Do you have any record of sales?

A. No.

Q. Do you have any ledger?

A. Not that far back, no; I wouldn’t keep my books after so many years.

Considering such facts with defendant’s pleading in three places in its counterclaim that its first use of VOODOO was on April 15, 1940, (which is later than September 10, 1938, the application date in plaintiffs’ registration of VOODOO which issued on January 3, 1939) leads to the conclusion that defendant was not prior to plaintiffs and could not sustain any burden of proving use of VOODOO prior to plaintiffs.

Let us examine defendant’s testimony and the background for such testimony, and see if defendant has over-

come the presumption of plaintiffs' registration and filing dates.

**Defendant's Background Is Pertinent
As to Credibility of Its Proofs.**

Mr. Rolley admits that he entered the perfume business by copying wellknown perfumes (R. 125, 138, 139, 163, 164, 188, 189, 194-197). The names and trade marks of these well known perfumes Rolley put on his lists (R. 193-197), such as (PX 1) although he claims he put only numbers on the bottles (R. 163). He used the famous trade marks of others orally to sell his so-called reproductions (R. 189). By these subterfuges, Mr. Rolley thought he could trade on the marks of others with impunity, because he saw nothing wrong in such infringements and unfair competition, which he warmly defended in Court (R. 189, 194, 195).

This continued until 1943 when Mr. Rolley admits that he received complaints from attorneys for perfume houses whose trade marks he was infringing (R. 138, 139, 194, 195). It seems that in 1944 Mr. Rolley's infringements were so bad that they attracted the attention of the District Attorney (R. 194), who is in charge of criminal prosecution of trade mark infringers. Mr. Rolley's testimony on this point is enlightening, as follows:

“District Attorney * * * asked me to come down there and I did * * * questioned me and asked me why I was doing this * * * told me * * * (it) was illegal to use comparisons like I was doing, that is, to refer to any other name on a printed sheet of paper. * * * They asked me to destroy or get rid of these particular copies of papers you have had in evidence here (PX 1) and they wanted it done in twenty-four hours” (R. 194).

Mr. Rolley admits infringing such famous trade marks as SHALIMAR, CHANEL 5 (R. 188), TOUJOURS MOI

(R. 197), and TABU (R. 193). In plaintiffs' exhibit 1 which is a list of Rolley infringements, Mr. Gaumer testified that MANDALAY belonged to Palmer's, Ltd., BALLET to Hudnut, WICKED to Peggy Sage, CURTAIN CALL to Marie Richelieu, FORBIDDEN to plaintiffs, WHITE CHRISTMAS to Caron, and CLARE DE LUNE to Colgate (R. 100, 101). Coty even stopped Rolley from registration in view of its prior ownership of a mark (R. 106, 107).

Such background is pertinent to the case at bar because a man who has made a practice of taking other people's trade marks cannot very well plead innocence. As stated in *Penn Co. v. M. L. B. & T. Co.*, 72 Fed. 422:

“It is a well established rule of evidence that, where the issue is the fraud or innocence of one in doing an act having the effect to mislead another, it is relevant to show other similar acts of the same person having the same effect to mislead, at or about the same time, or connected with the same general subject-matter. The legal relevancy of such evidence is based on logical principles. It certainly diminishes the possibility that an innocent mistake was made in an untrue and misleading statement, to show similar but different misleading statements of the same person about the same matter, because it is less probable that one would make innocent mistakes of a false and misleading character in repeated instances than in one instance.”

The above citation was approved and quoted by Judge Wilkerson in *Elgin National Watch Co. v. Elgin Razor Corp.*, 25 Fed. Sup. 886.

With this background in mind, we come to Mr. Rolley's first signing of the cross complaint alleging under oath that his first use of VOODOO was on April 15, 1940 (R. 16-20). Between the time that he signed the counter-

claims, he saw plaintiffs' registration of VOODOO with its filing date of September 10, 1938, and its registration date of January 3, 1939, and he also saw his counsel (R. 203). Mr. Rolley then admits that he wanted to get a date ahead of plaintiffs' registration (R. 204). Under these circumstances, it is difficult to believe that Mr. Rolley made any use of VOODOO prior to plaintiffs' date on its VOODOO registration. Mr. Rolley made many changes of dates in his discovery deposition. Some were for more than five years. For instance, he testified he went into the perfume business in 1938, but made it 1933 when he signed the deposition (R. 205). Considering such testimony, it is difficult to believe any of Mr. Rolley's dates.

Defendant Made No Trade Mark Search Prior to Using Voodoo.

Mr. Rolley, in adopting trade marks, has made it a policy never to have a trade mark search made to determine whether the mark is already registered or whether it is available (R. 123). Perhaps this is because he started out with his list of famous perfumes, whose trade marks belonged to others.

At any event, Mr. Rolley had no search made of the trade mark VOODOO before he began using it (R. 133). Even if he had had a search made and had found plaintiffs' registration of VOODOO, he might not have respected it, because he made a practice of copying well-known trade marked perfumes (R. 133, 192). In fact he has boasted of copying two hundred of them (R. 193). Mr. Rolley himself admitted that he did not know what he would have done had he made a search which disclosed plaintiffs' VOODOO registration (R. 133). He finally admitted he would make such a search today (R. 219), but did not say he would respect plaintiffs' registrations.

Registration is, of course, constructive notice of ownership and use of a trade mark to the public. Constructive notice is a necessary doctrine to protect registrants like plaintiffs from defendants like Rolley, Inc.

The Trade Mark Act of 1946 specifies in Sec. 22:

“Registration of a mark on the principal register provided by this Act or under the Act of March 3, 1881 or the Act of February 20, 1905, shall be constructive notice of the registrant’s claim of ownership thereof.”

In *Willson v. Graphol*, 89 USPQ 382, registrations under the Act of 1905 have been construed as providing constructive notice.

An Analysis of Defendant’s Evidence Discloses That Defendant Has Not Sustained Its Burden of Proof of Any Date of Use of Voodoo Earlier Than Plaintiffs’ Registration.

All of defendant’s testimony as to use of VOODOO prior to 1943 is oral, vague, and incredible. After Mr. Rolley had sworn in defendant’s counterclaim that his earliest use of VOODOO was on April 15, 1940, he testified in his discovery deposition that he did not go into the perfume business until 1938. He said 1938 several times (R. 119, 120, 131). When he signed the deposition he changed the date 1938 to 1933 (R. 119, 120, 131). He claimed orally in his discovery deposition to have used VOODOO in 1938 (R. 127), but changed that to 1934 or 1935 when he signed the same (R. 127). He admitted that he had nothing to back up such oral claims and that the first papers he could produce on VOODOO sales were in 1943 and 1944 (R. 147-149).

As a matter of fact, Mr. Rolley was in the shoe dye business from 1930 to 1943 (R. 186). He testified that “later I

made some money selling perfumes, and when I got to that point I gave up the dye business'' (R. 187). In 1940 Mr. Rolley was still in the dye business and Mrs. Anis did dyeing work for him (R. 258, 259). In 1943 he went into perfumes entirely (R. 259). This is confirmed because in 1943 we find the first documents on sales of perfume by Rolley (R. 150). The sale of Rolley's perfumes up until 1943 was confined to Mr. Rolley's store (R. 132). As late as Mr. Rolley's discovery deposition in 1950, his VOODOO perfume was sold only in San Francisco in defendant's store (R. 136). It was not on sale in any of the department stores in San Francisco (R. 136). Mr. Rolley admitted on cross-examination that he had no record of any sales of VOODOO perfume or cologne outside of San Francisco prior to 1943 (R. 136, 137).

The other witnesses do not help the defendant establish proof of priority by the preponderance of the evidence. There are six witnesses, but their testimony is valueless. Defendant desperately wanted to establish a date of use of VOODOO prior to September 10, 1938, the filing date of plaintiffs' VOODOO registration which was issued by the United States Patent Office on January 3, 1939.

A thorough study of the record in this case does not disclose any documentary or credible proof of any use of VOODOO by defendant on perfume prior to either of the above dates in 1938 or 1939.

Anybody can orally state that he has used a trade mark before the date of a registered mark. But is it believable? Is it sufficient to knock out a registration duly issued and of record for more than twelve years?

Mr. Rolley, president of defendant corporation and its predecessor as an individual, was a fluent witness in his own behalf. He was really in the shoe dye business until

1943 (R. 169, 186), so that plaintiffs' registration for VOODOO was already four years old when Mr. Rolley really went into the perfume business.

While Mr. Rolley was making his living dyeing shoes and garments, he potted with face creams and perfumes according to Mr. Moreland (R. 224). He gave some free samples to a next door neighbor, a Miss Homilius (R. 241-243). But there is nothing documentary to establish that he ever used the trade mark VOODOO on perfume while he was in the dyeing business.

Mr. Rolley's oral statement that he first used VOODOO in 1934 or 1935 (R. 166) is purely self serving and unsupported. In fact, it is contradicted by defendant's own witness, Miss Homilius, who testified that at that time there were no names on any of the perfume bottles (R. 244), because Mr. Rolley used only numbers and that VOODOO was not on any bottles he gave to her (R. 242, 244).

In 1939, Mr. Rolley was still selling perfumes with numbers on them instead of trade marks (R. 237-240). This came out in the testimony of another of defendant's witnesses, a Mrs. Labhard. She testified that at that time she "made suede garments" (R. 234), and "Mr. Rolley was cleaning and dyeing suede garments and shoes" (R. 234). There was a display case, she said, containing some of Mrs. Labhard's suede garments and some of Rolley's dyes and a small display of perfume in Mr. Rolley's dyeing shop (R. 235). She testified:

"Q. Did you notice whether any of these containers of perfume had any name on them?

A. No, sir. So far as I recall there were no names. The perfumes were sold by numbers only then." (R. 235).

Even with leading questions by defendant's counsel as

to whether she saw a VOODOO label, Mrs. Labhard said on the stand: "I don't recall a label" (R. 237).

The credibility of any witness in a law suit may be the subject of examination. This is particularly true of a witness who is relying on purely oral testimony to upset a documentary registration (R. 148). The background of such a witness, his purposes, business practices and conduct are all important in determining whether or not the witness should be believed.

Mr. Rolley began by copying other famous perfumes and attracted business by selling at a lower price (R. 162). His customers wanted to buy "that particular perfume they had liked" (R. 163) "at a cheaper price than they were accustomed to paying" (R. 162). "That was a reproduction", admitted Mr. Rolley (R. 163).

Later Mr. Rolley says that he was "called upon by some representative of some perfumery association" (R. 164) and was advised that his selling of reproductions of famous perfumes "was of doubtful propriety" (R. 164). Mr. Rolley even admitted that he copied the famous trade marked perfumes such as TOUJOURS MOI, a product of Corday (R. 165), SHALIMAR and CHANEL NO. 5 (R. 188) and used their names (R. 188). He admitted putting out "a list of famous perfumes with the names of wellknown trade marks on that list" (R. 193). Mr. Rolley said "I have copied TABU" (R. 193). When questioned on such practices, Mr. Rolley said that "all department stores" and "practically every perfume saleslady" did the same thing (R. 188, 189). That, of course, is not true and does not excuse Mr. Rolley's conduct or release him from trade mark infringement and unfair competition. With such an attitude and such a background, Mr. Rolley's oral statements are subject to grave doubt and disbelief.

Mr. Rolley's claim of a 1934 use of VOODOO as a trade mark on perfume is not supported by any corroborating witnesses. He could not furnish the names and addresses of any purchasers (R. 146, 147). This is strange. Usually a man in a new business can remember vividly his early customers. A lawyer certainly never forgets the name of his first client. Mr. Rolley did mention a Mrs. Coffey and a mysterious woman who had married three times and was now in Sacramento (R. 167). Mrs. Coffee could not be checked and for all we know, was fictitious. The Sacramento woman was supposed to appear as a witness and we even delayed the hearing an extra day for her, but she never showed up (R. 266). Maybe she never existed, because Mr. Rolley could not even remember her name (R. 167). Mr. Rolley said Mrs. Wiggley was an early customer, and claimed she purchased from him in 1940 (R. 200), but his memory was several years ahead, because Mrs. Wiggley testified she had no dealings with Mr. Rolley until 1943 (R. 247).

When Mr. Rolley was pressed on cross-examination as to why he had picked the date of April 15, 1940, and swore to it in his answer as his first use of VOODOO, he said that it was purely his "oral guess" (R. 217).

In no place in his testimony does Mr. Rolley definitely state that he used VOODOO as a trade mark on perfume at any date prior to plaintiffs' registration of VOODOO in 1939.

The mere creation or coining of a word does not confer trade mark rights. Mrs. Rolley claims that she told her husband about VOODOO, and gives the amazing reason that she picked it as an oriental word for an oriental type of perfume (R. 269, 279). She went on to say that she read a lot and had read about a tribe practicing voodooism in the orient, and that suggested the oriental word VOO-

DOO (R. 279). VOODOO has, of course, nothing to do with the orient so that an article thereon would be as doubtful as Mrs. Rolley's explanation. One can only conclude that Mrs. Rolley's testimony is entitled to no more weight than that of any wife trying erroneously to help her husband.

Although Mr. and Mrs. Rolley claim they named one of Mr. Rolley's perfumes VOODOO in 1934, and Mrs. Rolley claims to have seen perfume so labelled, yet this is contradicted by the testimony of Miss Homilius, who said that Mr. Rolley used only numbers on his bottles (R. 242, 244). Five years later, in 1939, Mr. Rolley was still using only numbers on his perfume, according to defendant's witness, Mrs. Labhard (R. 235).

Defendant cannot acquire trade mark rights in VOODOO by using VOODOO orally or by telling friends about it or by discussing it with his wife. To set aside plaintiffs' registration of VOODOO, defendant will have to establish beyond a reasonable doubt that its predecessor Mr. Rolley used the name VOODOO on a label attached to a bottle and sold it in a bona fide sale. Orally calling a perfume VOODOO, talking about it to friends, giving free samples to neighbors, is not sufficient.

Mr. Moreland's testimony was evidently intended by the defendant to establish trade mark use of VOODOO in 1934. All that it amounted to was that the word VOODOO was discussed. When asked to fix the time when Mr. Rolley first actually used VOODOO as a trade mark on perfume, the witness said:

"As far as using the name is concerned, I don't know when he started using it. (R. 212) My contact with the (Rolley) retail business is practically zero. * * * I had no connection with the retail business whatsoever." (R. 228).

Mr. Moreland testified:

“Q. Can you tell us the date when you first saw a bottle of perfume bearing the name VOODOO on Mr. Rolley’s premises?”

“A. God, no, I couldn’t tell you that.”

Mr. Moreland then concluded:

“The retail side of the business I didn’t have any knowledge of.” (R. 231).

Miss Homilius, who got free samples of Mr. Rolley’s perfume in numbered bottles, testified:

“Q. You can’t testify here this morning on the stand as to any date when you ever received a bottle from Mr. Rolley that had the name VOODOO on it, can you?”

“A. No.” (R. 245).

There is no documentary proof of any sales of perfume bearing a VOODOO label by Mr. Rolley prior to plaintiffs’ filing and registration dates of 1938 and 1939. There is no credible proof of any such trade mark use of VOODOO on said goods by Mr. Rolley prior to plaintiffs’ 1938 and 1939 documentary dates. Defendant’s own proof establishes that Mr. Rolley used numbers on his perfume. There is no proof of any rights by defendant prior to those of plaintiffs of record in the United States Patent Office.

There is further testimony by defendant’s witnesses relating to dates in 1943, 1944 and later, such as Mr. Rolley’s testimony that he discontinued the shoe dye business in 1943 and that he had never made any but retail sales of perfume from his place of business prior to 1943 (R. 167-169). Mrs. Rolley admitted that she sold perfume for Mr. Rolley for the first time in 1943 (R. 278). Mrs. Anis, who did dyeing for Mr. Rolley in 1940, began selling perfume for him in 1943 (R. 257). She is the witness who claimed she could recognize invoices she had typed by just

looking at the typing (R. 259). This impossible feat merely disclosed her eagerness to help her employer. Mrs. Wiggley said she bought Mr. Rolley's perfume in 1943 (R. 248). But this testimony is all oral by interested witnesses including Mr. Rolley's wife, employee and friends. And it is all on dates many years subsequent to plaintiffs' filing and registration dates in 1938 and 1939.

There is no documentary or credible oral proof of prior use of VOODOO by Mr. Rolley as defendant's predecessor on perfume that pre-dates plaintiffs' registration of VOODOO in 1939.

Defendant admits that it has never had any advertising of VOODOO perfume or cologne except in its price lists (R. 137, 209, 210). Naturally, this would be true because defendant would ride on plaintiffs' extensive national and local advertising of their VOODOO perfume and cologne. After this suit had been filed, defendant placed one advertisement in the San Francisco Chronicle on September 27, 1951, offering SEA AND SKI cream for \$1.00 and a free bottle of VOODOO perfume (R. 209, 210). Perhaps defendant offered to give away its VOODOO perfume because it is an admittedly "slow seller" (R. 214). Such free gifts indicate strongly that defendant's VOODOO perfume is not really on bona fide sale and that said trade mark is of no value to defendant. Certainly, the purchasing public does not associate the trade mark VOODOO with defendant.

It is also interesting to note that for the last two years that defendant has not had enough interest in or sale of VOODOO to list it in its price lists (R. 211, 212). This again indicates that defendant has had no actual sale of VOODOO for over two years and that it is not listed as really being on sale by defendant at the present time.

Defendant's Claim That Plaintiffs Are Not Entitled to Rely on Their Trade Mark Registrations Is Without Merit.

Defendant claims that plaintiffs' registrations are not entitled to the presumptions of validity, ownership and use, to which they are entitled under the Act of 1946, and the authorities.

How can defendant say that plaintiffs are not entitled to the protection granted them by said registrations and under the law? Defendant did not challenge or attack plaintiffs' registrations in any way. Defendant did not cross-examine plaintiffs' witness and obtain any proof against the existence or validity of plaintiffs' registrations. Defendant did not offer any proof of its own to attack or destroy plaintiffs' registrations. Plaintiffs' testimony did not, of course, adversely affect plaintiffs' registrations in any way. Defendant did not prove that plaintiffs did not use VOODOO prior to registration. How can defendant say that plaintiffs' registration of VOODOO is invalid? There is not a single iota of proof by defendant along this line.

Defendant's brief does not and cannot contradict the Act of 1946. Mr. Rolley claimed orally that he first sold VOODOO perfume in 1934. However, Mr. Rolley's oral claims of priority were admittedly not corroborated by sales invoices, ledger sheets, label receipts, or records of any kind (R. 147, 148). On the other hand, Mrs. Labhard and Miss Homilius, defendant's own witnesses, in effect contradicted and impeached Mr. Rolley in testifying that from 1934 to 1939 Mr. Rolley used only numbers and did not use names as trade marks on his perfumes (R. 235, 244, 245).

In all of defendant's harangue against plaintiffs' registrations, defendant cites no authorities to explain how it

may avoid infringement under the specific terms of the Act of 1946, to the protective provisions of which plaintiffs are entitled.

In *Lehn & Fink v. Wyeth*, 77 USPQ 633, the law is stated.

“In the absence of contrary evidence, registration is *prima facie* evidence of registrant’s ownership and use of mark.”

There is no evidence to the contrary. There is no evidence attacking plaintiffs’ registrations. They are presumed to be valid, and further, to be owned and the mark used by the owner. That is the fact in this case. Plaintiffs’ registrations are owned by plaintiffs. They are valid and the presumptions of validity and use are unrebutted and on dates prior to defendant.

Defendant dislikes the requirement that it has the burden of establishing ownership and use over one who owns a registration for such mark. Such a rule is necessary. Otherwise, we would have situations wherein one who had taken the trouble and expense to register a mark and given notice to all, of his rights thereto, could be deprived of his rights by any unsupported oral claim of priority. Proof of priority under such circumstances must be by the preponderance of the evidence, and all doubts must be resolved against the later claimant. Such is the law set forth in the California case of *Western Stove Company v. George D. Roper*, 82 Fed. 2nd 206.

Certainly defendant is the junior party who is attacking the registration. It has not met the proof required by it under the authorities to overcome plaintiffs’ registrations.

Defendant Mistakenly Claims That Plaintiffs' Voodoo Registration Has Expired. It Has Not Expired and Is in Full Force and Effect.

Plaintiffs must correct defendant's statement on page 33 of defendant's brief that "The asserted registration under the 1905 Act would have expired on January 3, 1949 (ten years)." This is not true.

Plaintiffs' registration No. 363,746 for the trade mark VOODOO was issued on January 3, 1939, by the United States Patent Office. A certified copy of this registration offered and received in evidence as plaintiffs' Exhibit 8 (R. 80), shows on its face that "The certificate of registration was granted for the term of twenty years and so far as is disclosed by the records of the office, said certificate is still in full force and effect."

The Act of February 20, 1905, Section 12, under which registration No. 363,746 for VOODOO was issued provided (U.S.C. Title 15, Sec. 92) "That a certificate of registration shall remain in force for twenty years."

Registration No. 363,746 for VOODOO, having issued on January 3, 1939, did not expire on January 3, 1949, and will not expire until January 3, 1959. It was during all of 1949 and still is in full force and effect.

Defendant also mistakenly urges on page 33 of its brief that plaintiffs' registration No. 363,746 for VOODOO was not entitled to republication under the Act of 1946. Again, this is not true. The citation of 15 USCA 1062 states that the owner of a trade mark registration obtained under the Act of 1905 may file "at any time prior to the expiration of the registration" to obtain the benefits of the Act of 1946. Plaintiffs' registration No. 363,746 for VOODOO had not expired on March 11, 1949, when plaintiffs filed under the Act of 1946. On August 9, 1949, when registra-

tion No. 363,746 for VOODOO was republished under the Act of 1946, plaintiffs' said registration became entitled to all of the benefits of the Act of 1946. The 1946 Act did not cut short plaintiffs' registration, so that defendant's statement on page 33 of its brief that "Apparently all claims under the asserted 1939 certificate have lapsed and expired" is false and misleading to the Court.

The California and Federal Cases Cited by Defendant Require That Plaintiffs' Registrations Be Sustained.

Defendant, confronted with plaintiffs' trade mark registrations, attempts to argue that they are a nullity on pages 35-41 of its brief. Defendant cites several California cases, all of which sustain plaintiffs' position.

The first of these cases is *Derringer v. Plate*, 29 Cal. 292, in which the Supreme Court of California sustained a common law trade mark on Derringer for pistols, and held that, even though plaintiff was in Philadelphia and defendant was in San Francisco, that defendant's use of Derringer on the same goods constituted infringement. The defendant's demurrer had been sustained below on the ground that plaintiff had had no registration in California and that registration was necessary. The Supreme Court ruled that plaintiff could prevail on his common law rights but that through registration of a trade mark, "its enjoyment may be better secured and guarded, and infringements upon the rights of the proprietor may be more effectually prevented and redressed by the aid of statute than at common law."

In *Weatherford v. Eytchison*, 90 C.A. (2d) 379, the Court cited *Derringer v. Plate*, *supra* and said that the California registration statute is "an affirmance of the common law."

In *Cole of California v. Grayson*, 72 C.A. (2d) 772, the Court restrained defendant from further use of SWOONER on apparel as an infringement of plaintiff's trade mark SWOONER on bobby sox. The plaintiff had registered the trade mark SWOONER in California and the Court held that while registration was not compulsory that such registration did "lend support to the finding that plaintiff had appropriated said trade mark in connection with the merchandise it manufactured and sold."

The Court further said:

"The certificate thereafter issued to the plaintiff by the Secretary of State constituted a registration of the trade mark under Section 14237 of the Business and Professions Code and such registration 'is prima facie evidence of the ownership of the mark' by the express terms of Section 14271 of said code."

The remaining California cases of *Rainier Brewing Co. v. McCalagon*, 94 C.A. (2d) 118, relates to receivership sales of trade marks.

Of the Federal cases cited by defendant, *Pecheur Co. v. National Co.*, 315 US 666 held that where there were no registrations that the action became one of common law unfair competition. The Trade Mark Cases, 100 US 82, related to criminal action under the Trade Mark Act of 1870, not involved in this case. *American Trading Co. v. H. E. Hancock*, 285 US 247, involved the Philippine Islands Trade Mark Act, and *United Drug Co. v. Rectanus*, 248 US 90, related to common law marks and the Act of 1881. None of these is pertinent to this case which involves the Acts of 1946 and 1905.

Before plaintiffs' registrations were granted by the United States Patent Office, plaintiffs satisfied the highly exacting and critical requirements of this expert government agency as to adoption and use. Such applications

are exhaustively searched and prior to registration are published for opposition. This publication permits anyone claiming prior rights thereto to object and present his evidence. Defendant filed no opposition. No others objected upon publication and plaintiffs' registrations were duly granted. They then became entitled to all of the benefits and presumptions of the Act of 1905 under which they were granted. Upon republication under the Act of 1946, plaintiffs have become and are now entitled to all of the benefits and presumptions of the Act of 1946. These cannot be wiped out by defendant's flimsy oral claims of priority, or by the unsupported argument of defendant's counsel that registrations confer no rights.

Plaintiffs cite the case of *McLellan Stores Co. v. Conrad & Co., Inc.*, 18 F. 2d 826, wherein the Court of Appeals for the District of Columbia held that a registration granted by the Patent Office is *prima facie* evidence of ownership during the entire twenty year period for which the registration is granted, saying:

“Section 16 of the Trade Mark Act provides ‘that the registration of a trade mark under the provisions of this act shall be *prima facie* evidence of ownership’. * * * Applicant contends that the *prima facie* presumption of ownership does not extend beyond the date of registration. * * *

“This contention was rejected by the Patent Office, and we think, correctly. Section 12 of the Trade Mark Act provides that a certificate of registration shall remain in force for twenty years. * * * Taking these provisions together, as we must, it is apparent that Congress intended that the owner of a mark should enjoy a continuing presumption of ownership during the life of the registration.”

Plaintiffs' registrations stand unexpired, un rebutted, and in full force and effect. They confirm plaintiffs' com-

mon law rights and have established presumptions as to use, ownership, and validity by plaintiffs, under the Acts of 1905 and 1946 and the authorities.

Pertinent Cases of This Court, The Supreme Court of the United States, and Other Courts of Appeal Sustain Plaintiffs' Position.

In *Stork Restaurant, Inc. v. Sabatini*, 76 USPQ 374, this Court said:

“The decisions frequently refer to this sort of imitation as ‘reaping where one has not sown’ or as ‘riding the coattails of the senior appropriator of the mark.’

“By whatever name it is called, equity frowns upon such business methods and in proper cases will grant an injunction to the rightful user of the trade mark.”

In *Del Monte Special Food Co. v. California Packing Corp.*, 34 Fed. 2nd 774, this Court restrained defendant from using DEL MONTE on oleomargarine in view of plaintiffs' prior and extensive use of DEL MONTE on food products because “the only motive for the adoption of the same brand is to get the advantage of appellee's name, reputation and good will.”

In *Safeway Stores, Inc. v. Dunnell*, 80 USPQ 115, this Court enjoined defendant's use of SAFE WAY on toilet seat covers in view of plaintiff's great use of SAFEWAY in its grocery stores. In the *Safeway* case as in the case at bar, the defendant knew of plaintiff's trade mark before beginning the infringing use.

In *Lentheric v. Willingmyre*, 45 USPQ 687, the District Court for New Jersey enjoined the defendant from repackaging plaintiff's merchandise and using plaintiff's trade mark because “the good will of plaintiff should not be injured in this way and the purchasing public should not be deceived or misled.”

In *Mishawaka Co. v. Kresge Co.*, 316 U.S. 203, the Supreme Court of the United States in affirming an injunction restraining the defendant from trade mark infringement said, "A trade mark is a merchandising short cut which induces a purchaser to select what he wants. The owner of a mark exploits this human propensity by making every effort to impregnate the atmosphere of this market with the drawing power of a congenial symbol. Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears. Once this is obtained, the trade mark owner has something of value. If another poaches upon the commercial magnetism of the symbol he has created, the owner can obtain legal redress."

In *California Fruit Growers v. Windsor Beverage*, 118 F. (2d) 149, the C. C. A. 7, in restraining infringement of the trade mark "SUNKIST" said, "If the trade mark is the same or similar and the merchandise such as reasonably may be attributed to plaintiff, deceit results. Plaintiff's having a property right in a trade mark may prevent others from enjoying that property right. * * * If defendants are not restrained, into the hands of the retailer comes an unlawful instrument which enables him to increase his sales of the dishonest goods, thereby lessening the market for the honest product. This the law will not permit."

**The Purchasing Public Associates Tabu,
Forbidden and Voodoo with Plaintiffs.**

Defendant argues that plaintiffs are not entitled to relief because they were originally small concerns. Defendant argues that plaintiffs' early sales were trifling in amount.

Defendant apparently feels that there is some stigma in starting a business from scratch and gradually working up to an accepted success. The story of plaintiffs is that of any successful American enterprise—namely, a small beginning and then coming up the hard way with products of their own to a gradual success, and recognition in the industry. What is wrong with that?

Plaintiffs' success in the perfume field is very important with relation to its trade marks in issue in this case. A trade mark is an important factor in the sale of perfumes. It may be the most important factor. Mr. Rolley has admitted that this is true (R. 139).

A trade mark is a commercial signature by which a pleased customer, or a new one, may obtain a desired product. Naturally, the greater the use of the trade mark, by means of advertising and sales, the greater the value of the trade mark, and the more likelihood there is of its being infringed. It is important in every case to show the extent to which the trade mark is in current and past use. That is why plaintiffs' testimony brought out that over two million dollars have been spent advertising plaintiffs' trade marked perfumes (R. 96), and that there have been over thirty-two million dollars in sales of said products (R. 90). Typical of plaintiffs' advertising is in evidence as plaintiffs' Exhibits 24-41 (R. 92). In VOODOO perfume and cologne alone plaintiffs' sales have exceeded over a quarter of a million dollars (R. 90). Plaintiffs' TABU and VOODOO cosmetics are on sale "in all the principal stores in California, Oregon and Washington" and "from coast to coast, in every city in the Union" (R. 90).

Just think of the good will connected with such sales. What does the purchasing public think of when it buys VOODOO? Does it think of defendant, who has not listed

its perfume for over two years? Does it think of defendant who has never advertised its VOODOO perfume, outside of the advertisement in which VOODOO was given away free with a purchase of another of defendant's products? Certainly the purchasing public does not think of defendant or its product. It does not know defendant, or defendant's product. It has heard of plaintiffs' VOODOO, and if it wants to buy VOODOO, it goes into any well known department store in California or elsewhere and buys plaintiffs' product.

Defendant says that plaintiffs are not selling perfume, but are brokers in trade marks. Plaintiffs are all related companies (R. 97). Plaintiffs' advertising and sales of their TABU, FORBIDDEN and VOODOO cosmetics extending into the millions refutes such claims.

Until 1943 Mr. Rolley claims he sold only retail (R. 132). Defendant's VOODOO is not now on sale in any San Francisco department store (R. 136). Compare that showing with the extensive sales of VOODOO made by the plaintiffs. Compare defendant's unsupported oral claim of use of VOODOO with plaintiffs' registration. Compare the lack of good will of defendant in VOODOO with the vast good will in said trade mark which the purchasing public and stores associate with plaintiffs.

**Plaintiffs Not Only Have Registrations With Prior Dates
But Their Products Have Been Sold and Are Now Being
Sold in California and Throughout the United States.**

Plaintiffs' registration of TABU goes back to 1934. (PX 2, R. 75). The VOODOO registration is dated 1938. These are documentary dates, not subject to a witness's oral guess, prejudice or mistake. They are established beyond doubt.

In addition, plaintiffs produced invoices showing sales of plaintiffs' trade marked products for 1943 to date (PX 85), in California and other parts of the country (R. 97-99). Sales prior to the dates of these invoices were made in Texas, California, Ohio, New York, and other places (R. 98).

The national and extensive advertising and sale of plaintiffs' TABU and VOODOO perfumes and colognes are established in the record (R. 89-90). Every department store in the San Francisco and the West Coast area carries and has carried plaintiffs' VOODOO and TABU perfumes and colognes (R. 89-91).

Mr. Rolley admits that a trade mark is an important factor in the sale of perfumes, and that a perfume becomes known by its advertising and sales and by its trade mark (R. 139). Since defendant's VOODOO product has been a slow seller (R. 214), and is given away with a purchase of another product (R. 209), it is difficult to see how defendant can claim that VOODOO indicates defendant's products. It is so unknown that it is not on sale in any San Francisco department store (R. 136) and has not even been listed for the last two years in defendant's own list (R. 212). Defendant has no good will in the trade mark VOODOO. On the other hand, because of plaintiffs' priority, extensive advertising, sale and use of VOODOO or its products, the trade mark has come to indicate only plaintiffs' products to the stores and the purchasing public. Plaintiffs and the purchasing public should be protected against defendant's infringing use of VOODOO.

Plaintiffs' Trade Marks Have Been Adjudicated by the Courts and Recognized by the Trade.

Plaintiffs' trade marks have been recognized by the Courts, the Patent Office and the trade.

The United States District Court for the Northern District of Illinois entered decisions sustaining plaintiffs' registered trade marks TABU and FORBIDDEN and issued injunctions restraining infringement thereof, as shown by certified copies offered in evidence as plaintiffs' exhibits 91, 92 and 93 (R. 103-105). The United States Patent Office denied registration of FORBIDDEN SECRET to the Lander Company as confusingly similar to plaintiffs' TABU and FORBIDDEN as shown by the decision offered in evidence as plaintiffs' Exhibit 90 (R. 104).

VOODOO, plaintiffs' registered trade mark was sustained and VOODOO BROWN restrained as an infringement thereof by the United States District Court for the Southern District of New York as shown in plaintiffs' Exhibit 94 (R. 105, 106). Two other VOODOO infringers avoided litigation by entering into settlement agreements with the plaintiff as shown in plaintiffs' Exhibits 95 and 96 (R. 106, 107).

This is strong evidence of the validity of plaintiffs' trade marks and indicative that these marks have the respect of the Court and the United States Patent Office and the acquiescence of competitors in the perfume trade.

Defendant's Counterclaim on Voodoo Is Without Basis And Should Be Dismissed.

When defendant's counterclaim was filed, defendant and defendant's counsel could not have been serious, because they alleged defendant's earliest use of VOODOO as April

15, 1940, which was later than plaintiffs' registration date of VOODOO in 1939 (R. 16-19).

At the trial, defendant's counsel sought to amend the 1940 date to 1934, without explanation (R. 71). This amendment was not granted (R. 71-72).

We have seen that the only data as to 1934 is Mr. Rolley's unsupported and oral claim of use of VOODOO, contradicted by two of defendant's own witnesses, Mrs. Labhard and Miss Homilius. They testified that in 1934 and still in 1939 Mr. Rolley was still using only numbers on his perfumes and used no trade marks or names thereon (R. 240, 244, 245).

Until the beginning of the year 1943, all (Mr. Rolley's) cosmetic sales were at retail for cash at his retail establishment in San Francisco" (R. 132). Such sales must have been very small because Mr. Rolley was in the shoe dyeing business and apparently had only one assistant, a Mrs. Anis from 1940 on (R. 251, 256). Mr. Rolley produced no person to testify that he or she bought perfume bearing a VOODOO label prior to 1943, although all sales, if any, prior to 1943 were made in San Francisco.

Defendant on page 10 of its brief claims that sales after 1943 by Mr. Rolley were extensive, but does not recite any amounts. Defendant admits that sales were confined to the three Pacific Coast stores, two territories and the District of Columbia (Pages 1 and 2 of defendant's brief). In fact, at the trial defendant's counsel indicated that an injunction covering only such territory would be sufficient to protect defendant.

Based on nothing but oral and contradicted proof of use of VOODOO as a trade mark on perfume prior to 1943, and long subsequent to plaintiffs' registration of

VOODOO in 1939, it is absurd for defendant to ask for an injunction.

Defendant's sales of VODOO must have been small because Mr. Rolley admitted that it was "a slow seller" (R. 214). It had never been advertised (R. 137, 209), until in one advertisement in 1951 for another product defendant offered to give away free a bottle of VODOO perfume (R. 137, 209). VODOO is not even included in defendant's current list of perfumes (R. 211, 212), which indicates that it has actually been dropped by defendant. Even without considering plaintiffs' rights, under such circumstances, what good will is there in defendant's claim to VODOO to protect by injunction? In addition, plaintiffs have a registered trade mark on VODOO which is entitled to be sustained.

Defendant's request for an injunction should be denied and its counterclaim dismissed with costs assessed against defendant.

The Preliminary Injunction Issued by Judge Erskine Restraining Defendant from Suing Any of Plaintiffs' Customers for Alleged Infringement of Voodoo and Made A Permanent Injunction by Judge Roche After Trial Should Be Affirmed.

At the time defendant filed its answer in this case, defendant improperly obtained, without serving notice on plaintiffs, an ex parte order dated June 7, 1950, to join twenty-one of plaintiffs' customers as parties to its cross complaint (R. 10, 11). These twenty-one customers of plaintiffs consisted of the following important stores: I. Magnin's, Bullock's, Owl Drug Company, Robinson's, Haggerty, all in Los Angeles; Saks, Wilshire Blvd., Beverly Hills; Emporium, Macy's, I. Magnin's, Hale Bros., City of Paris, H. Lieben & Co., J. Magnin's, Raphael

Weill & Company, White House, Owl Drug Company, all in San Francisco; Hale Bros., Owl Drug Company and Appleton & Co., all in San Jose; Capwell's, Sullivan & Furth, Capwell's, Kahn's and I. Magnin's, all in Oakland; Weinstock Lubin, Bon Marche, all in Sacramento (R. 10, 11).

Immediately upon learning of such ex parte order, plaintiffs filed a motion to vacate it and to strike the names of such stores from defendant's cross complaint.

Plaintiffs also filed a motion for preliminary injunction to restrain defendant from proceeding against said twenty-one customers of plaintiffs and from filing suit against any of plaintiffs' customers (R. 21-23). In support of this motion, plaintiffs filed the affidavit of John D. Gaumer, who set forth plaintiffs' registrations of VOODOO, their extensive advertising and sale throughout the United States and in California, including the twenty-one stores which defendant desired to sue (R. 24-29). Mr. Gaumer further stated that long after plaintiffs had obtained registration of VOODOO that defendant began the infringing sale of VOODOO perfume, that defendant had no rights to said trade mark, and that joining suit against said twenty-one customers was designed to harass plaintiffs and their customers. Mr. Gaumer's affidavit is set out in full in the Record (R. 24-29).

The matter was briefed and the authorities presented to His Honor, Judge Erskine. A leading case on the subject is that of *Maytag Co. v. Meadows Mfg. Co.*, 35 Fed. (2d) 403. The Court of Appeals for the Seventh Circuit there affirmed the granting of such an injunction saying that:

“The Court was justified in restraining the bringing of a multiplicity of suits which might result in irreparable injury to the appellee.” “

The matter was orally argued before the Court upon the record and the briefs thereon; after taking the case under advisement, Judge Erskine ruled in favor of plaintiffs (R. 31-33). His Honor entered two orders on December 28, 1950. One order set aside the *ex parte* order of June 7, 1950, and stated:

“As noted in the case of *Maytag Co. v. Meadows Mfg. Co.*, 35 F. (2d) 403, 410, ‘Public policy favors the rule that litigation for the purpose of ascertaining and sustaining alleged rights of a * * * manufacturer should be brought against the alleged wrongful manufacturer and that suits against the latter’s customers for the same relief should be restrained until the original suit shall be determined.’”

Judge Erskine’s other order granted plaintiffs’ motion for a preliminary injunction. It is set out in full in the record (R. 31-33).

During the trial, the testimony further sustained plaintiffs’ position. Mr. Gaumer testified that all of the twenty-one stores which defendant had endeavored to sue were plaintiffs’ customers selling plaintiffs’ VOODOO and TABU perfumes and colognes (R. 89, 90). On examination, Mr. Rolley testified (R. 135-136), that defendant had never sold VOODOO perfume to any of their stores.

In view of this showing and the authorities, plaintiffs request that the preliminary injunction issued by Judge Erskine be made permanent in this case.

**Defendant Had A Fair Trial. There Was No Prejudice
in the Decision of the District Court.**

Defendant argues throughout its brief, that the District Court was prejudiced by inadmissible material, on which some kind of a Statute of Limitations had run, and that a new trial should have been granted.

No Statute of Limitations or claim of laches can be seriously urged in this case. The evidence of which defendant complains was properly admitted under the cases set forth on page 21 of this brief.

This was a trial before the Court without a jury. The Court was certainly not affected by any improper evidence and gave proper consideration to the evidence presented. If any improper evidence was let in, it comes under the heading of harmless error and as such is specifically not a ground for new trial.

Rule 61 of the Rules of Civil Procedure for the United States District Court states: "No error in either the admission or the exclusion of evidence * * * is ground for granting a new trial."

Defendant seems to feel that the statements of the District Court denying defendant's motion for a new trial show prejudice against defendant. The Court's remarks set out in full in the record, (R. 281-282), show that defendant lost because it infringed plaintiffs' marks. The Court said that the defendant "clearly violated the law." Defendant's counsel then specifically asked the Court "With respect to VOODOO?" and the Court answered, "Yes". This shows the Court ruled on the evidence on VOODOO, and was not prejudiced.

It is fundamental that the District Court Judge who saw and heard the witnesses, had the best opportunity of evaluating their testimony. In the absence of manifest error, his findings should be accepted. Defendant has shown no mistake of fact or law in this case.

Defendant had a fair trial, and fair consideration of its motion for a new trial. It has no basis to complain of the decision against it, by the District Court.

CONCLUSION.

In all trade mark cases, it is necessary for the plaintiffs to show that defendants are using a trade mark confusingly similar to plaintiffs, that the goods of both parties are in the same general class and that plaintiffs' dates are earlier.

In the case at bar, there is no dispute about the marks because VOODOO used by defendant is an infringement of plaintiffs' VOODOO. The marks are identical. FORBIDDEN FLAME taken by defendant is confusingly similar to plaintiffs' FORBIDDEN and the synonymous TABU. The goods of all the parties are perfumes and cosmetics, so that there is no question as to similarity of the merchandise. The dates of plaintiffs' VOODOO and TABU registrations in 1938 and 1934 are far earlier than any dates established by defendant.

Therefore, since defendant has used confusingly similar marks to those of plaintiffs on the same class of goods, at later dates than those of plaintiffs', plaintiffs are entitled to prevail.

Since defendant does not dispute the goods or marks, let us examine more in detail the matter of dates.

Plaintiffs' registration of TABU was issued by the United States Patent Office on July 3, 1934. Defendant's earliest claim of use of FORBIDDEN FLAME was in 1939. Plaintiffs unquestionably have the earlier date.

Plaintiffs filed their application for registration of VOODOO in the United States Patent Office on September 10, 1938. After meeting the exacting requirements of the Patent Office, and subsequent to an exhaustive search of prior marks by the Patent Office, plaintiffs' application was published. No one, including defendant,

claimed prior rights or opposed, and plaintiffs' registration of VOODOO was granted on January 3, 1939.

Plaintiffs' registration of TABU, FORBIDDEN and VOODOO are existing, unexpired and in full force and effect. They were duly republished under the Act of 1946 and are entitled to all of the benefits of that Act. Plaintiffs' registrations are *prima facie* evidence of ownership, validity, and of plaintiffs' exclusive right to the use of said trade marks. Such evidence has not been rebutted by defendant, who did not attack plaintiffs' registrations nor present credible evidence of priority sufficient to overcome the evidence established by plaintiffs' registrations.

Mr. Rolley's claim of use of VOODOO in 1934 is oral and unsupported. It is challenged by plaintiffs who point out that two of Mr. Rolley's own witnesses, Mrs. Labhard and Miss Homilius contradicted Mr. Rolley and said that he used only numbers in 1934 and 1939 to designate his perfumes. Since he used numbers and did not use names, he did not use VOODOO as a trade mark on his perfumes.

Mr. Rolley produced no documentary proof. He offered no books, ledgers, sales invoices or label receipts to support his claim of use prior to plaintiffs' registration date of 1939. Mr. Rolley produced no witness who had made a bona fide purchase of any perfume bearing VOODOO as a trade mark thereon prior to 1943. This is more than four years after plaintiffs' registered date. Since all of Mr. Rolley's sales of perfume prior to 1943 were made in San Francisco, it is strange that he could not produce a single witness to prove an earlier sale of VOODOO. He could not even remember the name of the woman from Sacramento who is supposed to have bought from him, but who never appeared to testify at

the trial. Mr. Rolley could not produce such a witness. because he had not used VOODOO as a trade mark on perfume. He had used only numbers on the reproductions of famous perfumes which he admitted he had sold. The use of numbers on bottles is an old expedient of trade mark pirates who refer orally to well known trade marks of others in selling their infringing goods. Mr. Rolley's testimony as to any date earlier than plaintiffs' registration is self serving, oral, unsupported, contradicted, incredible and entitled to no weight whatsoever.

Defendant could not acquire trade mark rights by discussing VOODOO orally with friends or with his wife. Priority may be established only by corroborated proof of actual bona fide sales of goods on which the trade mark is used.

Mr. Rolley admits that until 1943 all sales of VOODOO were made at retail in San Francisco. After 1943 defendant claims that sales were made only in the three Pacific coast states, Alaska, Hawaii and the District of Columbia. No sales were made to the rest of the country. VOODOO perfume has never been advertised by defendant except in one recent advertisement in which a bottle of VOODOO perfume was offered free with purchase of another of defendant's cosmetics. The only place where defendant's VOODOO perfume was possibly on sale at the time of the trial was at defendant's store in San Francisco. It is on sale in none of the department stores in San Francisco or elsewhere. Defendant admits that its VOODOO perfume has been a slow seller. Defendant has not even included VOODOO in its current list of perfumes and has omitted VOODOO on such lists for more than two years. Sales are either nil, or so few that any good will that VOODOO has now associated with defendant must be dismissed as negligible.

On the other hand, plaintiffs' VOODOO perfume is on sale in every important department and drug store in the San Francisco area and throughout the United States. Sales and advertising of plaintiffs' VOODOO have been so extensive that practically every woman and store knows of plaintiffs' VOODOO products. The tremendous good will of such trade mark is associated with plaintiffs.

The California cases sustain plaintiffs' position that plaintiffs' registrations are valid and entitled to be sustained because defendant has not established priority by credible evidence. Defendant's evidence has merely amounted to admissions of infringement.

Plaintiffs respectfully submit that the decision of the District Court should be affirmed and this appeal dismissed with costs.

Respectfully submitted,

WILLIAM G. MACKAY,
111 Sutter Street
San Francisco, California

JAMES R. MCKNIGHT,
ROBERT C. COMSTOCK,
1 North LaSalle Street
Chicago, Illinois
Attorneys for Plaintiffs-Appellees.

